

Notice of Allowability

Application No.

09/539,269

Examiner

David E. England

Applicant(s)

HANNA ET AL.

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2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/27/2005.
2. ☒ The allowed claim(s) is/are 1 - 7, 9 - 17, 19 - 27, 29 and 30.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

W. C. Vaughn, Jr.
WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER

DETAILED ACTION

1. Claims 1 – 7, 9 – 17, 19 – 27, 29 and 30 are presented for examination.

Reasons for Allowance

2. The following is an examiner's statement of reasons for allowance: the closest prior art of record, (Arnold U.S. Patent No. 6,275,848, Beck et al. U.S. Patent No. 5,903,723, Young et al. U.S. Patent No. 6,243,466 and Eldridge et al. U.S. Patent No. 6,397,261), does not teach nor suggest in detail "examining the email message to determine if the email message includes an attachment; and
3. if the email message includes the attachment, asking a sender of the email message whether to replace the attachment with a reference specifying the location of the attachment;
4. if the sender agrees to replace the attachment, storing the attachment at a location on a communication network from which the attachment can be retrieved, modifying the email message by replacing the attachment with a reference specifying the location of the attachment on the communication network, sending the modified email message to a recipient of the email message, providing proof of receipt of the contents of the attachment, wherein providing proof of receipt involves;
5. delivering an encrypted version of the attachment, receiving a receipt for the encrypted version of the attachment, wherein the receipt includes a hash of the encrypted attachment, and in response to receiving the receipt for the encrypted version. sending the decryption key for the

attachment, wherein sending the decryption key for the attachment in response to receiving the receipt for the encrypted version proves reception of the exact contents of the attachments, and

6. deleting the attachment from the location on the communication network after one of:

7. receiving a notification that all recipients of the email message have retrieved the attachment, and receiving a notification that all recipients of the email message have deleted the email message.” as argued by the Applicant (see Remarks dated 09/06/2005, pages 12 – 13; Specification as of 05/09/2005, pages 7 – 11; and Drawings dated 09/07/2004, Figures 2, 2a and 3 of Applicant’s enabling portions of the specification and drawings).

8. Neither Arnold, Beck, Young nor Eldridge teach, teach alone or in combination, providing the decryption key in response to receiving a receipt for the encrypted version of the attachment, wherein the receipt proves reception of the exact contents of the attachment. Arnold, Young and Eldridge teach a system that utilized replacing attachments from an e-mail with links to a server in which the attachment is now stored. The user receiving the email and having the permission to access the attachment by selecting the link.

9. Beck teaches editing an e-mail by saving the attachment on a server and sending a link in its place. With in the link, there is a decryption key that gives the user the ability to select the link and retrieve the attachment in an encrypted format and have it decrypted as soon as it arrives because of the decryption key already in the link, (e.g., cols. 7 and 8). In contrast, the Applicant’s invention does not submit the decryption key along with the modified e-mail. The Applicant’s invention teaches just a link to the attachment that is in the e-mail and the user selecting the link, sending the attachment in encrypted format and using a hash value to send to the storage server to authenticate and acknowledge the receipt of the attachment. Then when the storage server

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receives a message about the user receiving the attachment, the storage server sends the decryption key to the user so the user can decrypt the attachment and view it. Because of the distinct difference between the prior art and invention, there is no motivation to combine the prior art to come up with the Applicant's invention because of the differences in how the communication between the user and the storage server when the user retrieves the attachment by selecting the link in the modified e-mail.

10. The dependent claims further limit the independent claims and are considered allowable on the same basis as the independent claim as well as for the further limitations set forth.

11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

12. Claims 1 – 7, 9 – 17, 19 – 27, 29 and 30 are allowed.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. a. Wantanabe U.S. Patent No. 6327612 discloses Electronic mail transmission with selective file attachment.

15. b. Jenkins et al. U.S. Patent No. 5812669 discloses Method and system for providing secure EDI over an open network.
16. c. Mital U.S. Patent No. 5903652 discloses System and apparatus for monitoring secure information in a computer network.
17. d. Liu et al. U.S. Patent No. 6760752 discloses Secure transmission system.

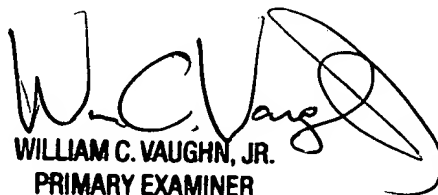
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

De



WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER